

REMARKS

In the Office Action mailed August 5, 2004, the Examiner rejected claims 23-26, 28-30 and 37-45. Claims 23-26, 28, 29, 31-44 and 46-52 are now pending in the application. Applicant have amended claims 23 and 37 to include the subject matter previously contained in now cancelled claims 30 and 45, respectively. Applicant has also amended claim 28. By way of the foregoing amendments and the markings to show changes Applicant is of the opinion that claims 23-26, 28, 29, 31-44 and 46-52 are in condition for allowance. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Interview with Examiner Kim

Applicants would like to thank Examiner Kim for the courtesy extended to the Applicant's representative, James M. McPherson, during a telephonic conference on September 28, 2004. During that conference, possible claim amendments and the appropriateness of use of certain references to formulate rejections were discussed.

With regards to the possible claim amendments, the Examiner agreed that patentable distinctions may exists between reference WO 00/43644 to Ritter et al. and the present invention in view of the advantages of the clips of the present invention. However, due to the finality of the Office Action, Examiner asserted that further distinctions made between the clips of the present invention and Ritter et al. would likely necessitate an additional search.

With regards to the appropriateness of the use of certain references to formulate non-obvious rejections, Applicant's Representative demonstrated to Examiner Kim why U.S. Patent No. 5,250,629 to Tani et al. should not be used to formulate a obviousness rejection due to the lack of motivation to combine Tani et al. with Ritter et al. It was further suggested that Tani et al. not only fails to teach its disclosed material as an oil pan, but does not even mention its applicability to engine components, in contrast to the assertions made in the previous Office Action. Applicant is of the opinion that a general statement that the Tani et al. material may be used in automobile parts, without additional explanation, does not constitute

motivation to use the material in the manufacturing of oil pans. During the phone conference on September 28, 2004, Examiner Kim agreed that the use of Tani et al. appeared inappropriate to formulate a rejection for non-obvious, due to a lack of motivation to combine the reference with the Ritter et al.

Claim objection and rejection under 35 U.S.C. § 112

Claim 28 is objected to for being dependent upon a canceled claim. Applicant has amended claim 28 to be dependent upon claim 23. Applicant is of the opinion that this amendment renders moot the objection to claim 28.

Claim 39 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with enablement requirements. More specifically, it has been asserted that a cure-on-demand, which resists curing until after the first and second mating surfaces are joined, as recited in claim 37, is incompatible with the cure-on-demand adhesive being curable upon removing a protective seal to expose the adhesive to ambient conditions, as recited in claim 39. Applicant is of the opinion, that in one embodiment of the present invention, it is clear that the protective seal recited in claim 39 allows the cure-on-demand adhesive to resist curing until after the first and second mating surfaces are joined and that the skilled artisan without undue experimentation would readily recognize how this can be done such as, for example, by removing the protective seal just prior to joining of the first and second mating surfaces. Other approaches are also possible.

Claims 23-26, 28-30 and 37-45

Claims 23, 28 and 29 are rejected under 35 U.S.C. §102(b) as being anticipated by WO 00/43644 to Ritter et al. Claims 24-26 and 37-45 are rejected under 35 U.S.C. §103(a) for being unpatentable over Ritter et al. in view of U.S. Patent No. 4,498,433 to Ogawa or in further view of U.S. Patent No. 4,374,717 to Drauglis et al. or in further view of U.S. Patent No. 4,985,523 to Mochizuki et al. or in further view of U.S. Patent No. 5,250,629 to Tani et al.

Without acquiescing to the Examiner's rejection, Applicant has amended claims 23 and 37 to include "said oil pan is a blend of a polyamide and a syndiotactic polystyrene", as previously presented in now cancelled claims 30 and 45. In view of

the Interview with Examiner Kim, as discussed above, it is believed that none of the references of record teach or suggest this feature. As such, Applicant is of the opinion that the rejections to claims 23 and 37 are rendered moot and are in an allowable form. Likewise, claims 24-26, 28 and 29, and claims 38-44, which are dependent upon claims 23 and 37, respectively, are also believed to be allowable.

Claims 31, 34-36 and 46-52

The Examiner has indicated that claims 31, 34-36 and 46-52 are allowed.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

### CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

Respectfully submitted,

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